

14. (New) The engine soundproof cover according to Claim 6, wherein a bulk density is not more than  $150 \text{ kg/m}^3$ .

15. (New) The engine soundproof structure according to Claim 10, wherein a bulk density is not more than  $150 \text{ kg/m}^3$ .

16. (New) The method of producing a shape memory foam member according to Claim 12, wherein a bulk density of the shape memory foam member is not more than  $150 \text{ kg/m}^3$ .

17. (New) The engine soundproof cover according to Claim 3, wherein the original shape of said shape memory foam member is substantially recovered via engine heat.

18. (New) The engine soundproof structure according to Claim 7, wherein the original shape of said shape memory foam member is substantially recovered via engine heat.

### REMARKS

Claims 1-3, 6, 7 and 10-18 are present in this application. By this Amendment, claims 3, 6, 7, 10 and 11 have been amended, claims 4, 5, 8 and 9 have been canceled, and claims 13-18 have been added. Reconsideration in view of the above amendments and the following remarks is respectfully requested.

Claims 1, 2, 5 and 9 were rejected under 35 U.S.C. §112, first paragraph. The Office Action contends that the coefficient of water absorption cited with units  $\text{g/cm}^3$  does not clearly define a property of the shape foam memory. To the contrary, as referenced in the present specification, JIS K6767 defines the coefficient of water

absorption with "g/cm<sup>3</sup>" even though the corresponding ISO 2896 defines such a coefficient in terms of "percent." According to JIS K6767, the mass (g) of water that is absorbed by a specimen is divided by the volume (cm<sup>3</sup>) of a foam member to be the specimen. Therefore, the coefficient of water absorption is expressed with the unit g/cm<sup>3</sup>. On the other hand, ISO 2896 takes the density of water (= 1 g/cm<sup>3</sup>) into consideration. Therefore, the result obtained under JIS K6767 should be divided by the density of water so that the result under ISO 2896 is expressed with a volume ratio (%), which of course has no dimensions.

In other words, the unit of JIS K6767 is different from that of ISO 2896 in that the coefficient of water absorption is described without considering the density of water. This means that both JIS K6767 and ISO 2896 substantially express the same result even though the unit systems are different from each other. If necessary, the Applicants will submit an English-language translation of JIS K6767.

Withdrawal of the rejection is thus respectfully requested.

Claims 1, 2, 4-6 and 8-10 were rejected under 35 U.S.C. §112, second paragraph. The Office Action contends that the term "substantially" renders the claims indefinite. To the contrary, however, the term "substantially" is commonly used in patent claims to prevent an infringer from avoiding literal infringement by minor changes, and is universally considered definite within the purview of 35 USC Section 112. See *NRDC v Great Lakes Carbon*, 188 USPQ 327, 333 (D. Del. 1975), wherein the court held:

The term 'substantially' in this element of the claim is one commonly used in patents to prevent the avoidance of literal infringement by minor changes which do not themselves cause a loss

of benefit of the invention. 1 A. W. Deller, Patent Claims 305 (2d ed. 1971). Indeed, there is authority for the proposition that its presence should always be implied in every claim, even when not introduced. *Musher Foundation, Inc. v Alba Trading Co., Inc.*, 150 F.2d 885, 889, 66 USPQ 183, 186-187 (2d Cir. 1945).

Also see the Federal Circuit's opinion in *York Products, Inc. v Central Tractor*, 40 USPQ2d 1619, 1622 (Fed. Cir. 1996) wherein the Court definitively indicated what "substantially" normally means in the context of patent claims unless the specification gives a novel use to the word: In this case, the patent discloses no novel uses of claim words. Ordinarily, therefore, "substantially" means "... largely but not wholly that which is specified, Webster's Ninth New Collegiate Dictionary 1176 (9th ed. 1983)."

Without an express intent to impart a novel meaning to claim terms, an inventor's claim terms take on their ordinary meaning. *Hoganas AB v Dresser Industries, Inc.*, 28 USPQ2d 1936, 1938 (Fed. Cir. 1993). In this case the patent specification discloses no novel use of the word "substantially". Therefore "substantially" means what it normally does.

Notwithstanding, at least Tables 1 and 2 on pages 34-35 of the present specification provide a clear basis for those of ordinary skill in the art to define the degree of shape recovery intended by use of the term "substantially." Withdrawal of the rejection is thus respectfully requested.

Claims 11 and 12 were rejected under 35 U.S.C. §102(b) over U.S. Patent No. 4,181,780 to Brenner. This rejection is respectfully traversed.

Without conceding the propriety of this rejection, claim 11 has been amended to define a step of providing the shape memory foam member having a coefficient of water

absorption in the range between  $0.01 \text{ g/cm}^3$  and  $0.2 \text{ g/cm}^3$  in a non-compressed state. As apparently recognized by the Examiner, due to the lack of a rejection over prior art of claim 1, this subject matter is lacking in the Brenner patent. In fact, Brenner is silent with respect to a coefficient of water absorption. As a consequence, Applicants submit that the rejection is misplaced. With respect to claim 12, Applicants submit that this claim is allowable at least by virtue of its dependency on an allowable independent claim.

Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 3, 4, 6-8 and 10 were rejected under 35 U.S.C. §103(a) over U.S. Patent No. 6,237,717 to Osanai in view of Brenner. Without conceding the propriety of this rejection, independent claims 3 and 7 have been recast as dependent claims, depending from claim 1. Since claim 1 has not been rejected over prior art, Applicants respectfully submit that this rejection is moot. Withdrawal of the rejection is respectfully requested.

Claims 13-18 have been added. With respect to the engine soundproof cover or structure, features and superiority thereof are discussed in the present specification at, for example, page 4, line 18 - page 5, line 21; page 6, lines 6-11; and page 7, line 15 - page 8, line 2.

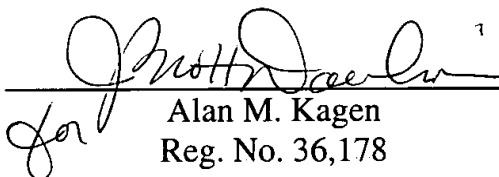
In view of the foregoing amendments and remarks, Applicants respectfully submit that the claims are patentable over the art of record and that the application is in condition for allowance. Should the Examiner believe that anything further is desirable in order to place the application in condition for allowance, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Prompt passage to issuance is earnestly solicited.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached pages are captioned "**Version With Markings To Show Changes Made.**"

Respectfully submitted,

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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE CLAIMS**

3. (Amended) An engine soundproof cover disposed to cover an engine,  
comprising:

[a] the shape memory foam member of claim 1 provided on a surface of said  
soundproof cover which covers the engine.

6. (Amended) The engine soundproof cover according to Claim [4] 3, wherein a  
bulk density is not more than  $400 \text{ kg/m}^3$ .

7. (Amended) An engine soundproof structure comprising:  
a soundproof cover disposed to cover an engine,  
wherein [a] the shape memory foam member of claim 1 is provided on a surface of  
said soundproof cover which covers the engine.

10. (Amended) The engine soundproof [cover] structure according to Claim [8]  
7, wherein a bulk density is not more than  $400 \text{ kg/m}^3$ .

11. (Amended) A method of producing a shape memory foam member  
comprising:  
providing the shape memory foam member having a coefficient of water  
absorption in the range between  $0.01 \text{ g/cm}^3$  and  $0.2 \text{ g/cm}^3$  in a non-compressed state;  
compressing the shape memory foam member with heating;  
cooling the shape memory foam member with keeping the shape memory foam  
member in the compressed state; and

releasing the shape memory foam member from the compressive pressure after cooling thereby retaining a shape in the compressed state.